

REMARKS

In the Office Action ("OA"), the Examiner rejected claims 1-3 and 6-10 under 35 U.S.C. § 103(a) as unpatentable over Jarett et al., U.S. Patent No. 5,911,120 ("Jarett") in view of Haartsen, U.S. Patent No. 6,112,088 ("Haartsen") and Willars, U.S. Patent No. 5,507,567 ("Willars"); rejected claims 11-14 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Haartsen; rejected claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Haartsen, Willars, and Grubeck et al., U.S. Patent No. 6,449,484 ("Grubeck"); and rejected claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Haartsen and Grubeck.

In response, Applicants respectfully submit that a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (8th Ed., Aug. 2001), (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143 at pp. 2100-122 to 127.

With regard to the rejection of claims 1-3 and 6-10, a *prima facie* case of obviousness has not been established because the applied references fail to teach or suggest at least a communication terminal that includes a control section configured to connect a first radio

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channel established by a first channel establishing section to a second communication terminal via a second radio channel established by a second channel establishing section, such that a communication channel between a first communication terminal and the second communication terminal can be established via the second radio unit, and similar methods recited or incorporated in these claims.

Furthermore, a *prima facie* case of obviousness has not been established because the references in each rejection, when taken alone or in combination fail to teach or suggest all the claim elements. Applicants will address each rejection separately in further detail below.

I. Rejection of claims 1-3 and 6-10 over Jarett in view of Haartsen and Willars

Independent claim 1 relates to a communication terminal having a first radio unit and a second radio unit. A first channel establishing section uses the first radio unit to establish a first radio channel to a base station. A second channel establishing section uses a second radio unit to establish a second radio channel to second communication terminal. The first and second radio channels have first and second radio frequency bands, respectively. In the communication terminal, a control section then establishes a communication channel between a first communication terminal and the second communication terminal via the first radio channel and the second radio channel. Therefore, a communication channel can be established from the first communication terminal through the communication terminal to the second communication terminal.

Continuing further, claim 1 recites, *inter alia*, “a control section configured to connect [a] first radio channel established by [a] first channel establishing section to [a] second communication terminal via [a] second radio channel established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit.”

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The Examiner correctly admitted that Jarett fails to teach such a feature. (OA at p. 3.) In particular, the Examiner acknowledged that Jarett does not teach a control section configured to connect the first radio channel established by the first channel establishing section to the another communication terminal via the second radio channel established by the second channel establishing section. (OA at p. 3.)

However, the Examiner alleged that Haartsen and Willars teach this claim element and that it would have been obvious to combine Jarett with Haartsen to arrive at the features of claim 1. Applicants respectfully disagree.

Haartsen and Willars fail to cure the deficiencies of Jarett. In Office Action, the Examiner asserts that Haartsen teaches a control for connecting a base station to another communication terminal over a first and second radio channel. (OA at p. 3.) Applicants respectfully submit that such an interpretation of Haartsen is incorrect.

Haartsen's mobile terminal establishes a first radio connection with a public land mobile telephone network to a calling party. Haartsen, col. 6, lines 9-22. Haartsen's mobile terminal also includes a "controlling means" that establishes a secondary radio communication connection with a private radio communications network. Haartsen, col. 6, lines 40-43. Haartsen's mobile terminal switches to the secondary radio connection, if the detected signal quality of the first connection falls below stored switching criteria. Haartsen, col. 6, lines 45-56. In other words, Haartsen teaches a mobile terminal that establishes redundant connections between itself and a calling party, not to another communication terminal.

Accordingly, Haartsen fails to teach or suggest at least a communication terminal that includes "a control section configured to connect [a] first radio channel established by [a] first channel establishing section to [a] second communication terminal via [a] second radio channel

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established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit," as recited by claim 1. That is, Haartsen fails to teach a communication channel that is established from a first communication terminal through the communication terminal to a second communication terminal. Haartsen instead teaches a mobile terminal that establishes redundant connections between only itself and a calling party. Haartsen at col. 6, lines 40-56. Since the redundant connections are for that same mobile terminal, Haartsen's mobile terminal does not establish a communication channel between a calling party and another communication terminal.

Therefore, Haartsen does not teach or suggest at least a communication terminal that includes "a control section configured to connect [a] first radio channel established by [a] first channel establishing section to [a] second communication terminal via [a] second radio channel established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit," as recited by claim 1.

Furthermore, the Examiner alleged that Willars teaches connecting a first radio channel to another communication terminal via a second radio channel such that a connection between a calling party and another communication terminal can be established simultaneously. (OA at p. 3.) Applicants respectfully submit that this interpretation of Willars is incorrect.

Willars discloses a mobile terminal similar to the one described in Haartsen. Willars' mobile terminal includes a hardware that establishes redundant radio channels if a change in a mobile network is detected. See Willars, Fig. 2. Specifically, Willars discloses that the a first radio channel is established between the mobile terminal and a mobile station for

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communications. Willars, col. 7, lines 13-29. Then, once the mobile terminal detects a change in the mobile network, such as a change in traffic on the network, the mobile terminal establishes a second radio channel with the mobile station. Willars, col. 7, lines 30-37. Finally, the mobile terminal switches communications to the second radio channel. Willars, col. 7, lines 30-37. Willars discloses that the first radio channel is maintained in a standby state in case network conditions change and communication needs to be switched back to this channel. Willars, col. 7, lines 38-44.

However, in contrast to the invention recited in claim 1, Willars does not disclose that the control section connects the first channel to another communication terminal via the second radio channel. As in Haartsen, Willars only teaches a mobile terminal that establishes redundant connections between only itself and a calling party. Thus, Willars fails to teach or suggest at least a communication terminal that includes “a control section configured to connect [a] first radio channel established by [a] first channel establishing section to [a] second communication terminal via [a] second radio channel established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit,” as recited by claim 1.

Accordingly, even if Haartsen and Willars were properly combinable with Jarett (which Applicants do not concede), the combination of Jarett, Haartsen, and Willars would still fail to teach or suggest “a control section configured to connect [a] first radio channel established by [a] first channel establishing section to [a] second communication terminal via [a] second radio channel established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit,” as recited by claim 1. Hence, a *prima facie* case of

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obviousness has not been established for claim 1 because the references fail to teach or suggest all the claim elements. For at least this reason, claim 1 is allowable.

Claims 2 and 3 are allowable at least due to their dependence from allowable claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.03 at p. 2100-126, (citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)).

Furthermore, claim 6 recites a channel connection method for a communication terminal that comprises, *inter alia*, "connecting [a] first radio channel established through [a] first radio unit to [a] second communication terminal via [a] second radio channel established through [a] second radio unit, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit." As mentioned above, Jarett, Haartsen, and Willars, taken alone or in combination, fail to teach or suggest such a feature. Thus, a *prima facie* case of obviousness has not been established for claim 6 because the references fail to teach or suggest all the claim elements. For at least this reason, claim 6 is allowable.

Claims 7-10 are allowable at least due to their dependence from allowable claim 6. M.P.E.P. § 2143.03 at p. 2100-126.

Moreover, there is no suggestion or motivation to modify Jarett, Haartsen, and Willars to produce Applicants' claimed invention. Even if the Examiner's allegations that "[i]t would have been obvious ... [to adapt Jarett] to include a control section," (OA at p. 3) were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify Jarett to produce Applicants' claimed invention. "The mere fact that references can be combined or modified does not render the resultant combination

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obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P.

§ 2143.01 at p. 2100-124 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)) (emphasis in original).

Since Jarett, Haartsen, and Willars, taken alone or in combination, do not teach or suggest all the recitations of Applicants’ claimed invention, and there can be no suggestion or motivation in the cited references to modify them, Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants’ present invention. Similarly, without any motivation to modify Jarett, Haartsen, and Willars, there can be no reasonable expectation of success from modifying these references to somehow produce Applicants’ present invention.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-3 and 6-10. For at least this reason, claims 1-3 and 6-10 are allowable.

II. Rejection of claims 11-14 over Jarett in view of Haartsen

Claim 11 is directed to a communication terminal comprising a combination of elements including, *inter alia*, “a receiving section configured to receive a telephone number over [a] radio channel; a ceasing section configured to cease the established radio channel; and an originating section configured to originate a call to a party with the received telephone number.”

The Examiner correctly acknowledged that Jarett fails to teach or suggest receiving a telephone number over a radio channel or ceasing an established radio channel and originating a call to a party with a received telephone number. (OA at p. 8.) However, the Examiner alleged that it would have been obvious to combine Jarett and Haartsen to arrive at the features of claim 11. Applicants respectfully disagree.

Haartsen fails to cure the deficiencies of Jarett. Haartsen teaches base stations that originate a call based on a received telephone number and a location of the mobile terminal

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assigned to the received telephone number. Haartsen, col. 5, lines 42-53. Although Haartsen's mobile terminal may receive a telephone number, the telephone number is received only from a base station of a public land mobile network or a private radio communication network, not a communication terminal. Haartsen, col. 6, lines 50-65.

Therefore, Haartsen fails to teach or suggest at least a communication terminal having an originating section that originates a call to a party with a received telephone number, as recited in claim 11.

Accordingly, even if Jarett and Haartsen were properly combinable (which Applicants do not concede), the combination of Jarett and Haartsen would still fail to teach or suggest the combination of features recited in claim 11. Hence, a *prima facie* case of obviousness has not been established for claim 11 because the references fail to teach or suggest all the claim elements. For at least this reason, claim 11 is allowable.

Claim 12 is directed to a communication terminal comprising a combination of elements including, *inter alia*, "a receiving section configured to receive information from [a] base station over [a] first radio channel; and a sending section configured to send the received information to the another communication terminal over [a] second radio channel while the receiving section receives the information over the first radio channel."

As mentioned above, Jarett and Haartsen, fail to teach or suggest at least, a communication terminal having a sending section that sends received information to another communication terminal over a second radio channel while a receiving section receives the information over a first radio channel. Accordingly, even if Jarett and Haartsen, were properly combinable (which Applicants do not concede), the combination of Jarett and Haartsen would still fail to teach or suggest the combination of features recited in claim 12. Hence, a *prima facie*

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case of obviousness has not been established for claim 12. For at least this reason, claim 12 is allowable.

Claims 13 and 14 are allowable at least due to their dependence from allowable claim 12. M.P.E.P. § 2143.03 at p. 2100-126.

Moreover, there is no suggestion or motivation to modify Jarett and Haartsen to produce Applicants' claimed invention. Even if the Examiner's allegations that "[i]t would have been obvious ... [to adapt Jarett] to include receiving a telephone number over a radio channel," (OA at p. 8) were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify Jarett to produce Applicants' claimed invention. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 at p. 2100-124.

Since Jarett and Haartsen, taken alone or in combination, do not teach or suggest all the recitations of Applicants' claimed invention, and there can be no suggestion or motivation in the cited references to modify them, Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants' present invention. Similarly, without any motivation to modify Jarett and Haartsen, there can be no reasonable expectation of success from modifying these references to somehow produce Applicants' present invention.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 11-14. For at least this reason, claims 11-14 are allowable.

III. Rejection of claims 4 and 5 over Jarett in view of Haartsen, Willars, and Grubeck

Claims 4 and 5 depend from claim 1, and, thus, incorporate the elements of that claim. As mentioned above, Jarett, Haartsen, and Willars, when taken alone in combination fail to teach or suggest at least "a control section configured to connect [a] first radio channel established by

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[a] first channel establishing section to [a] second communication terminal via [a] second radio channel established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit," recited in claim 1 and incorporated in these claims. (See current Response, Remarks, Section I.)

Furthermore, Grubeck fails to cure the deficiencies of Jarett, Haartsen, and Willars. Grubeck teaches a base station that allocates a channel to a group of mobile stations based on their output power demands. Grubeck, col. 5, lines 50-60. Mobile stations that have similar output power demands are allocated the same channel. Grubeck, col. 5, lines 50-60. However, a base station that allocates the same channel to a group of mobile stations, as taught by Grubeck, is not the same as a communication terminal having a control section configured to connect a first radio channel to another communication terminal via a second radio channel, such that a communication channel between the calling party and the another communication terminal can be established. Therefore, Grubeck also fails to teach or suggest at least this feature incorporated in claims 4 and 5.

Accordingly, even if Jarett, Haartsen, Willars, and Grubeck, were properly combinable (which Applicants do not concede), the combination would still fail to teach or suggest at least "a control section configured to connect [a] first radio channel established by [a] first channel establishing section to [a] second communication terminal via [a] second radio channel established by [a] second channel establishing section, such that a communication channel between [a] first communication terminal and the second communication terminal can be established via the second radio unit," as incorporated in claims 4 and 5. Thus, a *prima facie*

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case of obviousness has not been established for these claims because the references fail to teach or suggest all the claim elements. For at least this reason, claims 4 and 5 are allowable.

Moreover, there is no suggestion or motivation to modify Jarett, Haartsen, Willars, and Grubeck to produce Applicants' claimed invention. Even if the Examiner's allegations that "[i]t would have been obvious ... to make the invention adapt to include a communication terminal with a transmission power of a first radio unit," (OA at p. 11) were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify Jarett, Haartsen, Willars, and Grubeck to produce Applicants' claimed invention. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 at p. 2100-124.

Since Jarett, Haartsen, Willars, and Grubeck, taken alone or in combination, do not teach or suggest all the recitations of Applicants' claimed invention, and there can be no suggestion or motivation in the cited references to modify them, Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants' present invention. Similarly, without any motivation to modify Jarett, Haartsen, Willars, and Grubeck, there can be no reasonable expectation of success from modifying these references to somehow produce Applicants' present invention.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 4 and 5. For at least this reason, claims 4 and 5 are allowable.

IV. Rejection of claims 15 and 16 over Jarett in view of Haartsen and Grubeck

Claims 15 and 16 depend from claim 12, and, thus, incorporate the elements of that claim. As mentioned above, Jarett and Haartsen, when taken alone in combination fail to teach or suggest at least "a receiving section configured to receive information from [a] base station

over [a] first radio channel; and a sending section configured to send the received information to the another communication terminal over [a] second radio channel while the receiving section receives the information over the first radio channel,” recited in claim 12 and incorporated in these claims. (See current Response, Remarks, Section II.)

Furthermore, Grubeck fails to cure the deficiencies of Jarett, Haartsen, and Willars. Grubeck teaches a base station that allocates a channel to a group of mobile stations based on their output power demands. Grubeck, col. 5, lines 50-60. Mobile stations that have similar output power demands are allocated the same channel. Grubeck, col. 5, lines 50-60. Therefore, Grubeck also fails to teach or suggest at least this feature of incorporated in claims 15 and 16.

Accordingly, even if Jarett, Haartsen, Willars, and Grubeck, were properly combinable (which Applicants do not concede), the combination would still fail to teach or suggest at least “a receiving section configured to receive information from [a] base station over [a] first radio channel; and a sending section configured to send the received information to the another communication terminal over [a] second radio channel while the receiving section receives the information over the first radio channel,” as incorporated in claims 15 and 16. Thus, a *prima facie* case of obviousness has not been established for these claims because the references fail to teach or suggest all the claim elements. For at least this reason, claims 15 and 16 are allowable.

Moreover, there is no suggestion or motivation to modify Jarett, Haartsen, and Grubeck to produce Applicants’ claimed invention. Even if the Examiner’s allegations that “[i]t would have been obvious ... to make the invention adapt to include a communication terminal with a transmission power of a first radio unit,” (OA at p. 12) were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify Jarett, Haartsen, and Grubeck to produce Applicants’ claimed invention. “The mere fact

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that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 at p. 2100-124.

Since Jarett, Haartsen, and Grubeck, taken alone or in combination, do not teach or suggest all the recitations of Applicants’ claimed invention, and there can be no suggestion or motivation in the cited references to modify them, Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants’ present invention. Similarly, without any motivation to modify Jarett, Haartsen, and Grubeck, there can be no reasonable expectation of success from modifying these references to somehow produce Applicants’ present invention.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 15 and 16. For at least this reason, claims 15 and 16 are allowable.

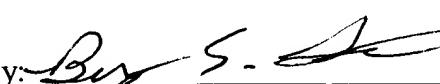
V. Conclusion

In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 16, 2003
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